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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,909	07/25/2007	Alan D. Olstein	21001.012US	7773
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Intellectual Property Dept. Dewitt Ross & Stevens SC 2 East Mifflin Street Suite 600 Madison, WI 53703-2865				
EXAMINER				
MARX, IRENE				
ART UNIT		PAPER NUMBER		
1651				
NOTIFICATION DATE		DELIVERY MODE		
07/01/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

doctet-ip@dewittross.com

### Office Action Summary

**Application No.**

10/597,909

**Applicant(s)**

OLSTEIN, ALAN D.

**Examiner**

Irene Marx

**Art Unit**

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.  
4a) Of the above claim(s) 14, 16-24 and 28 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13, 15, 25-27 and 29-31 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date 7/2/08, 5/22/09  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The application should be reviewed for errors.

To facilitate processing of papers at the U.S. Patent and Trademark Office, it is recommended that the Application Serial Number be inserted on every page of claims and/or of amendments filed.

Applicant's election with traverse of Group I, claims 1-13, 15, 25-27, and 29-31 is acknowledged.

The traversal is on the ground(s) that the reference cited to demonstrate a lacking technical relationship between the groups which involves the same special technical feature are not proper because the claims require a medium that "enhances" growth rather than "allows" *Listeria* to grow. However, applicant has failed to demonstrate differences in the media with objective evidence that would support that conclusion or indicated the degree of "enhancement" that might patentably distinguish one media composition over the other. In addition, the functional limitation asserted does not materially change the structure of the selective growth medium as claimed..

The claims as written are drawn to inventions which are not linked by a special technical feature to form a single general inventive concept as is required for unity of invention. That no objection to unity of invention was raised in the searching process in the PCT prosecution is not binding in the present case.

For the reasons outlined, the arguments are not persuasive of error in the lack of unity requirement made.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL. .

Claims 1-13, 15, 25-27, and 29-31 are being considered on the merits.

Claims 14, 16-24 and 28 are withdrawn from consideration as directed to a non-elected invention.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is confusing in the recitation of "a concentration of from about 5 g/l" without an indication of the endpoint of the range. Claim 6 lacks antecedent basis in claim 5 for an open-ended range.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee *et al.*.

The claims are directed to a growth medium comprising lithium chloride and antibiotics intended for *Listeria*.

Lee *et al.* disclose a growth medium comprising lithium chloride and antibiotics intended for *Listeria*. See, e.g., page 1215, col. 1, paragraph 2 and col. 3 paragraph 2.

Therefore, the invention is anticipated by the reference.

Claims 1, 4-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Difco Manual.

The claims are directed to a growth medium comprising lithium chloride and antibiotics intended for *Listeria*.

Difco Manual disclose a growth medium comprising lithium chloride and antibiotics intended for *Listeria*. See, e.g., pages 365 and 367-368.

Therefore, the invention is anticipated by the reference.

Claims 1, 4-6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Neamatallah *et al.*.

The claims are directed to a growth medium comprising lithium chloride and antibiotics intended for *Listeria*.

Neamatallah *et al.* disclose a growth medium comprising lithium chloride and antibiotics intended for *Listeria*. See, e.g., Table 1.

Therefore, the invention is anticipated by the reference.

Claims 1-13, 15, 25-27, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee *et al.* taken with Difco Manual and Neamatallah *et al.*

The claims are directed to a growth medium comprising lithium chloride and antibiotics intended for *Listeria*.

Lee *et al.* disclose a growth medium comprising lithium chloride and antibiotics intended for *Listeria*. See, e.g., page 1215, col. 1, paragraph 2 and col. 3 paragraph 2. The components of phenylethanol agar are disclosed by Difco Manual. See, e.g., page 395. In addition, the Difco Manual adequately demonstrates that the combination of various antibiotics in media for the detection of *Listeria* is old and well known in the art. See, e.g., pages 364-365.

The reference differs from the claimed invention in the addition of nitrofurantoin. However, Neamatallah *et al.* adequately demonstrate that it is known in the art to add nitrofurantoin to selective media intended for the recovery and/or identification of *Listeria*.

Regarding claim 31, all of the ingredients are known in the art to be suitable for selective media for *Listeria* and are provided at art recognized concentrations.

The media discussed in the references appear to be substantially similar as claimed. However, even if they are not, the adjustment of ingredients and concentrations for optimization purposes identified as result-effective variables cited in the references would have been *prima facie* obvious to a person having ordinary skill in the art, since such adjustment is at the essence of biotechnical engineering.

Generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation" In re Aller, 220 F.2d 454,456, 105 USPQ 233, 235 (CCPA 1955) -MPEP § 2144.05.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the composition of Lee *et al.* by adding nitrofurantoin as an additional selective tool, for the expected benefit of better selecting and identifying the dangerous pathogen *Listeria*.

Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 .

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Irene Marx/  
Primary Examiner  
Art Unit 1651